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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,336	10/04/2002	Jean-Hiram Coffy	F-575	2199
919	7590	06/03/2004	EXAMINER	
PITNEY BOWES INC. 35 WATerview DRIVE P.O. BOX 3000 MSC 26-22 SHELTON, CT 06484-8000			WOO, RICHARD SUKYOON	
		ART UNIT		PAPER NUMBER
		3629		
DATE MAILED: 06/03/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/065,336	COFFY ET AL.
	Examiner	Art Unit
	Richard Woo	3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 24 March 2004.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,6-12 and 16-27 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,6-12 and 16-27 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Response to Arguments***

- 1) The amendment filed on March 24, 2004 has been entered.

### ***Claim Rejections - 35 USC § 112***

- 2) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 3) Claims 1, 6-12 and 16-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 6-12 and 16-27 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are:

As for Claim 1, when the claim is directed to a method for a user for authorizing and providing evidence of payment of postage for a mail piece, there is no essential step to depict how this claim provides evidence of payment of postage (e.g., adding the step of "debiting from the user's account whenever handwriting a postage value field on the mail piece..."). All the steps are deemed to be mere non-functional steps that do not help establish or facilitate how the main object of the claim should be carried out. In this case, the user can handwrite whatever he/she wishes to write on the mail piece but without showing the essential step to link utilizing the digital pen to the payment scheme.

Additionally, the claim and specifications are also silent how to prevent the user from abusing the system. For example, the user can handwrite a postage value far lower than what it should be.

As for Claims 12 and 24, respectively, the claim is directed to a method for verifying payment of postage for a mail piece but there is no essential step to verify payment of postage (see Supra Claim 1 for the same omission).

***Claim Objections***

4) Claims 23-27 are objected to because of the following informalities:

In Claim 23, line 6; and Claim 24, line 8, respectively, --and-- should be inserted after ":"

In Claim 25, line 2; and Claim 26, line 2, respectively, "a" should be deleted after "using."

Appropriate correction is required.

***Allowable Subject Matter***

5) Claims 1, 6-12 and 16-27 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 2003/0046256 is cited to show a system for information management including a look-up unit, in which are stored particulars about a plurality of regions, each of which represents an area on at least one imaginary surface.

US 6,201,903 is cited to show a method and apparatus for sending a fax to provide for recording pen strokes that set forth a message and sending the recorded pen strokes as part of fax.

US 6,275,745 is cited to show a reading, storage and printing device including an electronic receipt table that is coupled to controller, a digital pen that is coupled to tablet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.

  
Richard Woo  
Patent Examiner  
GAU 3629  
May 28, 2004

  
DEANT. NGUYEN  
PRIMARY EXAMINER